

REMARKS

Rejections Under 35 USC §103

The Examiner rejects the claims under 35 USC 103 as being obvious under *Gilbert* in view of *Evans*. For the following reasons, the rejections under 35 USC 103 do not raise a *prima facie* case of obviousness, are improperly applied, and should be withdrawn.

1. There Must Be a Basis in the Art for Combining or Modifying References

MPEP§ 2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The Federal Circuit has several times expressly addressed the issue of how to evaluate an alleged case of *prima facie* to determine whether it has been properly made. Thus, *In re Geiger, supra*, stated, in holding that the PTO “failed to establish a *prima facie* case of obviousness”:

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 221 USPQ 929,933 (Fed. Cir. 1984).

Of course, application of §103 presumes the existence of differences between the subject matter claimed and the teachings of any particular prior art reference. Otherwise, a rejection under §102 would have sufficed. Thus, the Examiner must propose some modification of a particular reference or a combination thereof with another reference in order to arrive at the claimed invention. The Federal Circuit’s assessment in *Geiger*, quoted above, is directed to the sufficiency of the teachings of a particular reference to justify a conclusion that any proposed modification or combination of references is what one of ordinary skill in the art would have

found obvious to do at the time the invention was made.

Recently, Judge Newman in her opinion in *In re Lee*, 277 F3d. 1338, 1343, 61 USPQ2d 1430, (Fed Cir. 2002) repeats this fundamental principle:

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.

Judge Newman went on to advise the PTO that it cannot meet that test by simply saying that the basis for combining references comes from "common knowledge" or is "common sense", *viz*:

The "common knowledge and common sense" on which the Board relied in rejecting Lee's application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act...The Board's findings must extend to all material facts and must be documented on the record, lest the "haze of so-called expertise" acquire insulation from accountability. "Common knowledge and common sense", even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority. *Id.*

The CCPA earlier expressly held that there must be some logical reason apparent from the evidence of record that would justify a combination or modification of references. *In re Regel*, 188USPQ 132 (CCPA 1975). In determining whether one of ordinary skill in the art would find it obvious to modify or combine references, the teachings of the reference taken with the knowledge that a worker in the art already possesses constitute the scope and content of the prior art that is referred to in the *Graham* decision. Thus, the question raised under § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art. Accordingly, even if all elements of a claim are disclosed in

various prior art references, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill would have been prompted to combine the teachings of the references to arrive at the claimed invention. *In re Regel, supra*.

Prima facie obviousness does exist when the prior art suggests or anticipates the benefits of modifying or combining references or when external factors, such as the changing state of the art, provide the motivation to one of ordinary skill in the art to make the modification or combination. However, where no reasonable intrinsic or extrinsic justification exists for the proposed combination or modification, *prima facie* obviousness will not have been established.

Thus, it is important for the practitioner to examine whether there is an intrinsic basis in the prior art or some extrinsic factor that would prompt one of ordinary skill in the art to combine the teachings of the references. If there is not then the Examiner has not met the burden of establishing a *prima facie* case of obviousness, and it becomes a task of the practitioner to traverse the rejection by way of denying the existence of a *prima facie* case of obviousness.

The Federal Circuit has also repeatedly warned against using the applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art. *See, e.g., Grain Processing Corp. v. American Maize-Products*, 840 F2d. 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

The black letter law statements by Judge Linn in *In re Kotzab*, 217 F.3d 1365, 55 USPQ2d 1313 (Fed. Cir. 2000) address this subject, *viz*:

a) Hindsight Syndrome

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with

which the invention can be understood may prompt one “to fall victim to the insidious effect taught is used against the teacher.” (*Id.* At 1369, 55 USPQ2d at 1316) (citations omitted).

b) Need for Motivation

Most if not all inventions arise from a combination of old elements. ... Thus, every element of a claimed invention may often be found in the prior art. *See id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. (*Id.* at 1369, 55 USPQ2d at 1316) (citations omitted).

(c) Particular Findings Required

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. ... The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. ... Whether the Board relies on an express or an implicit showing, it must provide particular findings related thereto. Broad conclusory statements standing alone are not “evidence.” (*Id.* at 1370, 55 USPQ2d 1317) (citations omitted).

The Examiner does not provide a single motivation for either combining *Gilbert* with *Evans*, other than the assertion that *Evans* provides a basis for rejecting claims involving brail. Accordingly, *Gilbert* is treated more as a piece of art under 102, rather than 103, and to that extent the Examiner does not discuss the alterations to *Gilbert* needed to obtain the invention. The reason why seems clear: *Gilbert* is not the invention as claimed by the applicant, nor is there a justification for any modifications to *Gilbert* to get the invention claimed. The Applicant is

thus left to guess the nature of the alterations and to guess the motivations for alterations. This is clearly contrary to above cited law that requires the Examiner to specifically define elements, specifically identify alterations and the motivations for making the alterations, and to specifically identify motivation for making combinations. However, there are no findings that would justify a motivation to modify *Gilbert* to achieve any of the teachings of invention, much less the teachings in the claims. Further, the Examiner does not provide any findings to justify the modifications or combinations. Accordingly, withdrawal of the rejections to the claims based on *Gilbert* in combination with *Evans* under 35 USC 103 is respectfully requested.

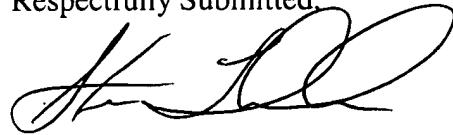
In the Event Arguments are Believed Insufficient

The Examiner is thanked for the phone interview, his consideration, and for acknowledging that there appears to be patentable subject matter in the present patent application even though he felt at the time of the interview that the unamended claims do not appear technically adequate. Should the Examiner disagree that the remarks place the application in condition for allowance, the Examiner is respectfully requested to prepare an acceptable proposed set of claims pursuant to MPEP 707.07 (j).

Thus, it is believed that the pending claims are allowable, and allowance of said claims is respectfully requested. Other references made of record but not relied upon in the Office Action are considered no more relevant to the invention than the reference relied upon by the Examiner.

If the Examiner has other matters which remain, the Examiner is encouraged to contact the under signed attorney to resolve these matters by Examiners Amendment where possible.

Respectfully Submitted,



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